

THE HONORABLE ROBERT S. LASNIK

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
AT SEATTLE

AVOCENT REDMOND CORP., a  
Washington corporation,

Plaintiff,

v.

ATEN TECHNOLOGY INC., a California  
corporation; ATEN INTERNATIONAL CO.,  
LTD., a Taiwanese Company; BELKIN  
INTERNATIONAL, INC., a Delaware  
corporation, and BELKIN, INC., a Delaware  
corporation.

Defendants.

Case No. 2:06-CV-01711 (RSL)

**DECLARATION OF YASSER  
EL-GAMAL IN SUPPORT OF  
DEFENDANTS' MOTION FOR  
LEAVE TO AMEND INVALIDITY  
CONTENTIONS**

**EL-GAMAL DECL. IN SUPPORT OF DEFENDANTS'  
MOTION FOR LEAVE TO AMEND INVALIDITY  
CONTENTIONS – CASE NO. 2:06-CV-01711-RSL**

1 I, Yasser El-Gamal, declare as follows:

2 1. I am a member of the bar of the State of California and a partner with the law  
3 firm of Dickstein Shapiro LLP, lead counsel for the Belkin Defendants in this matter. I  
4 am admitted to practice *pro hac vice* before this Court. I have personal knowledge of the  
5 matters set forth in this declaration and if called upon to testify in court, I could and would  
6 do so competently.

7 2. I make this declaration in support of DEFENDANTS' MOTION FOR LEAVE  
8 TO AMEND INVALIDITY CONTENTIONS, by which Defendants seek leave to  
9 supplement their invalidity contentions with the prior art contentions developed by other  
10 parties when the case was stayed as described in more detail below.

11 **EXHIBITS**

12 3. Attached hereto as Exhibit 1 is a true and correct copy of Defendants'  
13 proposed First Supplemental Combined Statement of Preliminary Invalidity Contentions  
14 (excluding Appendix C and D) in redline format.

15 4. Attached hereto as Exhibit 2, filed under seal, is a true and correct copy of  
16 Appendix C to Defendants' First Supplemental Combined Statement of Preliminary  
17 Invalidity Contentions (which is a copy of the Nov. 23, 2009 Expert Report of of Steven  
18 R. Eisenbarth, Ph.D., P.E. together with exhibits that was served on Avocent on or about  
19 November 23, 2009) ("Nov. 23, 2009 Eisenbarth Report").

20 5. Attached hereto as Exhibit 3, filed under seal, is a true and correct copy of the  
21 April 29, 2010 Rose Elecs. Mot. for Summ. J. of Invalidity of All 17 Claims Asserted  
22 Against the ServeView Pro Product Based on 35 U.S.C. § 102(g), Declaration of Peter  
23 Macourek, and Declaration of Gregory K. Storey in Support of Rose Elecs. Mot. for  
24 Summ. J. of Invalidity of All 17 Claims Asserted Against the ServeView Pro Product  
25 Based on 35 U.S.C. § 102(g) ("April 29, 2010 Rose MSJ Re: 102(g) Prior Invention of the  
26 Rose OSD Product"). Upon request, Defendants will provide the Court with the exhibits  
27 cited in April 29, 2010 Rose MSJ Re: 102(g) Prior Invention of the Rose OSD Product.

28 6. Attached hereto as Exhibit 4 is a true and correct copy of a letter from James

D. Berquist to Robert W. Dickerson, dated Nov. 14, 2011.

7. Attached hereto as Exhibit 5 is a true and correct copy of Order Granting Mot. to Am. Prelim. Invalidity Contentions (D.N. 59) *Play Visions, Inc. v. Dollar Tree Stores, Inc.*, No. C09-1769, (W.D. Wash. Nov. 30, 2010) (Pechman, J.).

8. Attached hereto as Exhibit 6 is a true and correct copy of Defendants' Combined Statement of Preliminary Invalidity Contentions, served June 15, 2007.

9. Attached hereto as Exhibit 7 is a true and correct copy of a letter from Robert W. Dickerson to James D. Berquist, dated Nov. 3, 2011.

10. Attached hereto as Exhibit 8 is a true and correct copy of a letter from Gregory K. Storey to James D. Berquist, dated Nov. 10, 2011.

11. Attached hereto as Exhibit 9 is a true and correct copy of an email from Gregory K. Storey to James D. Berquist, dated Nov. 14, 2011.

12. Attached hereto as Exhibit 10 is a true and correct copy of a letter from Robert W. Dickerson to James D. Berquist, dated Nov. 15, 2011.

13. Attached hereto as Exhibit 11 is a true and correct copy of a December 18, 2009 Order from the Court of Federal Claims.

### FACTS

14. This is not an ordinary patent case. Plaintiff Avocent ("Avocent") has asserted 40 claims (against Belkin alone) from three different patents (U.S. Patents 5,884,096, 6,112,264, and 7,113,978) and accuses of infringement dozens of Belkin products, extending across numerous product lines and families.

15. The patents in suit and their lengthy prosecution and litigation histories further complicate this case. The patents in suit all trace back to an application filed over a decade and a half ago on August 25, 1995 (now U.S. Patent No. 5,721,842). On January 16, 2007, the date Avocent amended its complaint to allege infringement against Belkin and ATEN, there were no fewer than seven related patent application file histories in the United States alone:

Pre-Stay Applications/File Histories

- a. U.S. Patent App.Ser. No. 08/519,193 filed 08/25/95 (Now USPN<sup>o</sup>. 5,721,842);
- b. U.S. Patent App.Ser. No. 08/970,168 filed 11/12/97 (Now USPN<sup>o</sup>. 5,937,176);
- c. U.S. Patent App.Ser. No. 08/969,723 filed 11/12/97 (Now USPN<sup>o</sup>. 5,884,096);
- d. U.S. Patent App.Ser. No. 09/244,947 filed 02/04/99 (Now USPN<sup>o</sup>. 6,112,264);
- e. U.S. Patent App.Ser. No. 08/590,170 filed 06/09/00 (Now USPN<sup>o</sup>. 6,345,323);
- f. U.S. Patent App.Ser. No. 09/683,582 filed 01/22/02 (Now USPN<sup>o</sup>. 7,113,978); and
- g. U.S. Patent App.Ser. No. 11/129,443 filed 05/16/05 (Now USPN<sup>o</sup>. 7,818,367).

16. As a result of this protracted prosecution history there were literally hundreds of prior art reference documents cited on the face of the patents. For example, there are over 100 U.S. Patent Documents cited on the face of the asserted '096 patent alone.

17. As of January 16, 2007, there were also numerous foreign related counterpart applications as well.

18. During the four-year stay, nine additional related U.S. applications were filed, eight of which were reexaminations of previously issued patents. The reexaminations were filed by Rose and were declared by United States Patent Office ("USPTO") after a finding of substantial new issues of patentability based on previously undisclosed prior art publication references and combinations thereof.

19. In addition to the numerous and lengthy prosecution histories, this case is further complicated by the fact that the patents-in-suit and related patents have a lengthy litigation history as well. In each of the following litigations, Avocent or its predecessor

Apex asserted the patents in suit, or patents directly related to the patents in suit:

Pre Stay Litigations

- 1998 – Apex sued CCC Group (Case No. WDWash 98CV739);
- 1998 – Apex sued Rose Electronics and Cybex (Case Nos. WDWash 98CV246; WDWash 98CV245)
  - Dismissed pending USPTO interference filed by Cybex (Perholz patent)
  - Avocent formed by merger of Apex and Cybex
- 2001– Avocent sued Raritan (*Raritan I*) (Case No. SDNY 01CV4435)
  - Bench trial resulted in verdict for Raritan
  - Federal Circuit reversed several claim construction rulings
  - Case settled in May 2005 on the eve of second trial
- 2006-07 – Avocent sued Rose, Aten, Belkin, and Trippe (Case No. WDWash 06CV1711)
  - Case stayed pending USPTO reexaminations filed by Rose
  - Stay maintained pending 2nd reexaminations and COFC case

20. Subsequently, during the four-year stay, Avocent continued to litigate these very patents-in-suit and filed two intervening law suits asserting the same patents it asserted against Belkin and ATEN as well as additional patents in the family:

Post Stay Litigations

- 2008 – *Avocent Redmond Corp. v. United States & Rose Electronics (Intervenor)*, (Ct. of Fed. Cl. Jan. 31, 2008) (Case No. COFC 08CV0069) (“*Rose II* litigation”)
  - Avocent sued United States in COFC for Rose sales to U.S.
  - Rose intervened and defended case
  - Settled prior to trial (7/20/11)
  - MSJ Re: 102(g) Prior Invention defense remained undecided at the time of settlement

- 1           •     2010 – *Avocent Redmond Corp. v. Raritan Americas, Inc.*, (S.D.N.Y Aug.  
2                 14, 2010) (Case No. SDNY 10CV4435) (*Raritan II* litigation)
  - 3                 ○   Avocent sued Raritan again after expiration of original 5-year  
4                 settlement license
  - 5                 ○   Case is pending, now in expert discovery phase.

6           21. As explained below, these post-stay Rose litigation and reexamination  
7     proceedings resulted in invalidity contentions that were not known or understood by  
8     Belkin before this case was stayed. Those invalidity contentions, which for years have  
9     been well known to Avocent, are the very contentions Defendants seek to incorporate into  
10    their invalidity contentions in this case.

22. The supplemental prior art incorporated into the proposed supplemental invalidity contentions (listed in Appendix A-1-Supp of the Exhibit 1) can be categorized into three groups:

**a. Documents Re: 35 USC 102(g) Prior Invention Defense Based on the Rose OSD**

<b>Products Offered for Sale, Publicly Used or Made Known</b>	<b>Person or Entity</b>	<b>Date Product Offered for Sale, Publicly Used or Made Known</b>
KVM switch sold to Black Box, consisting of VMCON4 Rev. I (KVM board) and PCB-OVL Rev. A (OSD board) ("Rose OSD product")	Rose Electronics	October 9, 1996

<b>Technical Rose Documents Re: Development of Rose OSD Product – 102(g) Prior Invention</b>	<b>Identification (if any)</b>
Rose Electronics, Station Master Installation and Operation Manual, Version 1.1, March 23, 1995	
Rose Electronics Schematic, Part No. VMCON4, Revision G ("VMCON4 rev. G")	ROSE 0243350-69
Rose Electronics Schematic, Part No. VMCON4, Revision H ("VMCON4 rev. H")	ROSE 0242335
Rose Electronics Schematic, Part No. VMCON4, Revision I ("VMCON4 rev. I")	ROSE 0242336
Rose Electronics Schematic, OSD Board, Feb. 1995 ("Feb. 1995 schematics")	ROSE 0242337
Rose Electronics Schematic, OSD Board, Aug. 1, 1995 ("Aug. 1, 1995 schematic")	ROSE 2948-2952
Rose Electronics Schematic, Doc. No. OVERLAY1.SCH, Rev. A ("Sep. 5, 1995 schematic")	ROSE 2657, 2769, 2779, 2846
Rose Electronics Schematic, Doc. No. OVERLAY3.SCH, Rev. A ("Sep. 14, 1995 schematic")	ROSE 3253
Rose Electronics Schematic, Doc. No. OVERLAY3.SCH, Rev. A ("Sep. 27, 1995 schematic")	ROSE 2931
Rose Electronics Schematic, Doc. No. OVERLAY4.SCH, Rev. A ("Nov. 8, 1995 schematic")	ROSE 2771
Rose Electronics Schematic, Doc. No. OVERLAY4.SCH, Rev. A ("Nov. 28, 1995 schematic")	ROSE 2903
Rose Electronics Schematic, File C:\ROSE\OVL\OVERLAY.SCH ("Dec. 19, 1995 schematic")	ROSE 2895
Rose Electronics Schematic, No. OVERLAY.SCH, ("Dec. 26, 1995 schematic")	ROSE 2894
Rose Electronics Schematic, No. OVERLAY.SCH, Rev. A ("Jan. 25, 1996 schematic")	ROSE 2860
Rose Electronics Schematic, Doc. No. A12MODOL.SCH, Rev. A ("Jan. 26, 1996 schematic")	ROSE 1001, 1011
Rose Electronics Schematic, No. PCB-OVL, Rev. A ("Feb. 20, 1996 schematic")	ROSE 2861

**b. Previously Undisclosed Japanese Foreign Language References from Japanese Foreign Counterpart Applications:**

Japanese Laid Open Pat. App. No. 5-27721	Horiuchi	February 5, 1993
Japanese Laid Open Pat. App. No. 5-81196	Ishihara et al.	April 2, 1993

**c. Diefendorff et al., PolyCon, Engelbart, Howse, Tragen/Q-Net References:**

Patents/Applications	Inventors	Issue/Pub. Dates
US 3,541,541	Engelbart	November 17, 1970
US 4,404,551	Howse et al.	Septemebr 13, 1983
WO 87/00317	Tragen et al.	January 15, 1987
EU 0174099	Diefendorff et al.	March 12, 1986

Publications:	Document Identification (if any)
The PolyCon Management System Ordering Catalog, 1994 ("PolyCon")	ROSE 0004609-24
Microscience Corp., Q-Net Installation and Operation Manual and related documents	ROSE 0244871-82; ROSE 0244883-5113

Products Offered for Sale, Publicly Used or Made Known	Person or Entity	Date Product Offered for Sale, Publicly Used or Made Known
Q-Net Resource Manager	Microscience Corp.	1985

23. Invalidity contentions based on the foregoing prior art was served on Avocent at least over two years ago in Rose's Nov. 23, 2009 Eisenbarth Report. (Exhibit 2 hereto)

24. In addition, the invalidity contentions relating to the Prior Invention of the Rose OSD KVM product was also again served on Avocent in connection with Rose's April 29, 2010 Rose MSJ Re: the 102(g) Prior Invention of the Rose OSD Product. (Exhibits 2 and 3 hereto).

25. **Prior Invention of Rose OSD KVM Product:** As set forth in the Vision Winter and Ming-Tao Yang Declarations filed contemporaneously herewith, the prior invention of the Rose OSD KVM Product was unknown to Belkin or ATEN at any time

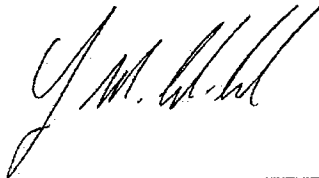


1 before the October 30, 2007 stay. Even though Rose was a co-defendant in this litigation  
2 prior to the October 30, 2007 stay, Rose was represented by separate counsel and did not  
3 disclose the existence and significance of the prior conception or reduction to practice of  
4 the Rose OSD KVM Product to Belkin at any time before the October 30, 2007 stay. It is  
5 my understanding from Rose's lawyers Mike Dowler, Jeff Phillips and Greg Storey (who  
6 is now representing ATEN) that they themselves did not know that Rose had an earlier  
7 conception and reduction to practice of the Rose OSD KVM Product (which is  
8 substantively identical to one of the accused products) until after this case was stayed.  
9 Accordingly, this prior art -- which was uniquely in Rose's possession, custody and  
10 control -- was previously unknown and unavailable to both Belkin and ATEN.

11 **26. Japanese References (Horiuchi and Ishihara et al).:** These are two Japanese  
12 prior art references that were cited in connection with a Japanese foreign counterpart  
13 application, that do not appear to have been produced to Belkin prior to the case being  
14 stayed.

15 **27. Diefendorff et al., PolyCon, Engelbart, Howse, Tragen/Q-Net:** These items  
16 of prior art were discovered after the case was stayed in connection with *Rose II* litigation  
17 and/or employed as prior art referenced in connection with the reexaminations initiated by  
18 Rose, some of which were combined with the Horiuchi and Ishihara references as the  
19 basis of invalidity contentions developed by Rose and set forth in the Nov. 23 Eisenbarth  
20 Report and/or the reexamination requests.

21 I declare under penalty of perjury under the laws of the United States that the  
22 foregoing is true and correct. Executed this 1st day of December, 2011 at Irvine,  
23 California.

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25  
26  


27 Yasser El-Gamal  
28

CERTIFICATE OF SERVICE

I hereby certify that on December 1, 2011, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

John A. Knox  
Williams, Kastner & Gibbs PLLC  
601 Union Street, Suite 4100  
Seattle, Washington 98101-2380  
jknox@wkg.com

James D. Berquist  
J. Scott Davidson  
Donald L. Jackson  
DAVIDSON BERQUIST JACKSON &  
GOWDEY, LLP  
4300 Wilson Blvd, Suite 700  
Arlington, Virginia 22203  
jay.berquist@davidsonberquist.com  
scott.davidson@davidsonberquist.com  
dlj@dbjg.com

Thomas F. Ahearne  
Joel B. Ard  
Foster Pepper PLLC  
1111 Third Avenue, Suite 3400  
Seattle, WA 98101-3299  
ahearne@foster.com  
ArdJB@foster.com

Ming-Tao Yang  
Gregory K. Storey  
Finnegan, Henderson, Farabow, Garrett &  
Dunner, LLP  
3300 Hillview Avenue  
Palo Alto, CA 94304-1203  
Ming.yang@finnegan.com  
greg.storey@finnegan.com

Robert W. Dickerson  
Yasser El-Gamal  
Dickstein Shapiro, LLP  
2049 Century Park East, Suite 700  
Los Angeles, CA 90067  
dickersonr@dicksteinshapiro.com  
elgamaly@dicksteinshapiro.com

Jeffrey A. Miller  
Dickstein Shapiro, LLP  
700 Hanson Way  
Palo Alto, CA 94304  
millerj@dicksteinshapiro.com

David P. Enzminger  
Winston & Strawn LLP  
333 South Hope Street  
Los Angeles, CA 90071  
denzminger@winston.com

Jeffrey J. Phillips  
Winston & Strawn LLP  
1111 Louisiana, 25th Floor  
Houston, TX 77002  
jphillips@winston.com

s/ Michael A. Moore

Michael A. Moore, WSBA No. 27047  
CORR CRONIN MICHELSON  
BAUMGARDNER & PREECE LLP  
1001 Fourth Avenue, Suite 3900  
Seattle, Washington 98154-1051  
Telephone: (206) 625-8600  
Fax: (206) 625-0900  
e-mail: mmoore@corrchronin.com